

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES E. SCHINNER

Appeal 2008-0514
Application 09/962,050
Technology Center 2600

Decided: September 9, 2008

Before MAHSHID D. SAADAT, ROBERT E. NAPPI,
and KARL D. EASTHOM, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1-6, 8-15, 17, and 18. Claims 7 and 16 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention relates to a handheld electronic device that allows a user to selectively modify all variable device option parameters, and to save the user-selective modifications either as a power-on default setting or as a user-specific "personality mode" setting (Spec. 2). According to Appellant, a storage medium stores operational parameter values (Spec. 3) while at least one personalization mode storage area stores user-selected preferred operational parameter values (Spec. 4).

Claim 1, which is representative of the claims on appeal, reads as follows:

1. A handheld electronic device comprising:

a processor for controlling operation of said handheld electronic device according to program instructions and operational parameter values;

a storage medium for storing operational parameter values, including a power-on storage area which stores initial operational parameter values that are loaded into a working memory of said processor upon initial powering-on of said handheld electronic device, and at least one personalization mode storage area which stores user-selected preferred operational parameter values that are selectively loaded into memory upon user selection after powering-on of said handheld electronic device; and

an interface located on said device that enables the user to assign a user-selected identifier to each personalization mode storage area.

The prior art applied in rejecting the claims on appeal is:

Anderson	US 6,134,606	Oct. 17, 2000
(hereinafter Anderson '606)		
Anderson	US 6,222,538 B1	Apr. 24, 2001

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(hereinafter Anderson ‘538)

Ed Bott, “*Dual-Booting Do’s and Don’ts*,” Special Edition Using Microsoft Windows Millenium Edition, Nov. 3, 2000.

The Examiner rejected claims 1, 2, 4-6, 8-11, 13-15, 17, and 18 under 35 U.S.C. § 103(a) based upon the teachings of Anderson ‘606 and Anderson ‘538 and claims 3 and 12 under 35 U.S.C. § 103(a) based upon the teachings of Anderson ‘606, Anderson ‘538, and further in view of Bott.

Rather than repeat the arguments here, we make reference to the Briefs (Supplemental Appeal Brief, filed Feb. 22, 2007 and the Reply Brief, filed May 14, 2007) and the Answer (mailed Mar. 22, 2007) for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant did not make in the Briefs have not been considered and are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Appellant argues that “an interface located on said device that enables the user to assign a user-selected identifier to each personalization mode,” as recited in claims 1 and 10, is neither taught nor suggested by the combination of Anderson ‘606 and Anderson ‘538 (App. Br. 6-8). Therefore, the issue is whether under 35 U.S.C. § 103(a), would the ordinarily skilled artisan have found it obvious to modify Anderson ‘606 with Anderson ‘538 to provide the above-mentioned limitation and render the claimed invention unpatentable?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (citing *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. “Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). *See also In re Kahn*, 441 F.3d at 988 (Fed. Cir. 2006).

ANALYSIS

1. *Claim rejection over Anderson ‘606 and Anderson ‘538*

Appellant does not dispute the teachings of Anderson ‘606 with respect to the claimed processor and storage medium in a handheld

electronic device. However, Appellant's contentions focus on whether Anderson '538 teaches the recited interface and more specifically, whether the selection of a script from a menu is the same as assigning a user-selected identifier to the script (App. Br. 6). Appellant further contends that the Examiner's characterization of the highlight box as a user-selected identifier is incorrect since the user manipulates the positioning of the highlight box to be moved to a menu item for selecting a desired script (Reply Br. 3-4).

The Examiner responds (Ans. 8-9) that using a highlight box to highlight menu selections for running a script is disclosed in Anderson '957 (US Patent 6,177,957), which is mentioned in Anderson '538 and incorporated by reference (Anderson '538, col. 11, 42-51). The Examiner further asserts that highlighting menu selections for running a script disclosed in Anderson '957 is the same as the claimed user-selected identifier (*id.*). The Examiner concludes that, giving the broadest reasonable interpretation to the claim terms, the "user-selected identifier" reads on the highlight box since the user is assigning this box to a desired script (*id.*).

We agree with the Examiner's findings in Anderson '538 and further find that the reference provides for a scripted set of commands for operating a digital camera to guide the user through a set of predetermined functions (col. 2, ll. 43-49). As recognized by the Examiner (Ans. 4), Anderson '538 uses a script, including directed image capture sequences, that is determined by a program written by the user (col. 10, ll. 39-48). The script may be selected by the user from a menu where it is displayed for selection (col. 10, ll. 49-52). The reference relies on a related invention for methods of updating the scripts using a removable memory (col. 11, ll. 8-19).

We further find that Anderson ‘538 provides for displaying a list of available directed image capture sequences that are categorized in menus for easier selection (col. 11, ll. 20-25). As an example, in the context of capturing images by a real estate agent, Anderson ‘538 displays categories such as “commercial,” “industrial,” and “residential” for selection which are designed to capture pictures of different types of buildings (col. 11, ll. 26-34).

In fact, contrary to Appellant’s argument (Reply Br. 3-4), the Examiner refers to the highlight box as the visual means for selecting from a list of scripts wherein the content of the box is a script listed by its category or label similar to the claimed “identifier” (Ans. 4 and 9). Consistent with the Examiner’s line of reasoning, we find that categorizing the scripts is the same as assigning a user-select identifier to that script and the storage area, where it is stored. The categories disclosed by Anderson ‘538, which are useful to a real estate agent, are similar to “situations” disclosed in Paragraph [0018] of Appellant’s Specification, which states:

For purposes of the invention, the configuration mode storage areas 203-206 are designed as user identifier areas, but it will be noted that the different areas equally could correspond to *different photographic situation identifiers*, and be labeled as such by the user, as illustrated in the previous paragraph. As examples, different photographic situations would be identified as bright daylight, moving subject, overcast, night, portrait, close-up, etc.
(Emphasis added.)

As such, the claimed “user-selected identifier” is no more than a label for a particular situation that requires specific settings for the operation of the device. Similarly, Anderson ‘538 discloses situations, such as the type of

the building the agent is to photograph, which are labeled by user-selected categories or identifiers.

For all of the above discussed reasons, we simply find no error in the Examiner's position that the script categories highlighted by the highlight box, as taught by Anderson '538, would be recognized by the skilled artisan as assigning a user-selected identifier to each mode or script or the storage area where the script is stored, as recited in claims 1 and 10.

Therefore, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 1 and 10 based upon the teachings of Anderson '606 and Anderson '538. Regarding claims 2, 4-6, 8, 9, 11, 13-15, 17, and 18, since Appellant has not separately argued their patentability apart from their dependence from claims 1 and 10 (App. Br. 8 and 10), these claims fall with their base claims and their rejection is likewise sustained. *See* 37 C.F.R. § 41.37(c)(1)(vii).

2. *Claim rejection over Anderson '606, Anderson '538, and Bott*

Similar to the rejection of the other dependent claims, Appellant argues patentability of claims 3 and 12 merely based on their dependence from their base claims (App. Br. 10-12). Thus, for the same reasons discussed above, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 3 and 12 based upon the teachings of Anderson '606, Anderson '538, and Bott.

DECISION

The decision of the Examiner rejecting claims 1-6, 8-15, 17, and 18 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. 1.136(a)(1)(iv).

AFFIRMED

gvw

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